

Appl. No. 09/661,992
Amdt. dated October 8, 2003
Preliminary Amendment

PATENT

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1-24 are currently pending and subject to a restriction requirement. Upon entry of this amendment, claims 8, 10-12, 15 and 23 are amended without prejudice or disclaimer. Claims 17, 20-22 and 24 are also canceled upon entry of this amendment without prejudice or disclaimer. These claims are canceled solely because they are directed to non-elected subject matter. Applicants retain the right to reintroduce these claims in this or another application.

New claims 25-27 are introduced upon entry of this amendment. These claims find support throughout the specification including, for example, pages 11-19. Thus, following entry of this amendment, claims 1-16, 18-19 and 23 are pending.

II. Objections to the Specification

Claims 8, 10 and 12 are objected to because the claims recite to certain amino acids, whereas the specification indicates that the recited sequences are nucleic acid sequences. These claims have been amended to refer to the appropriate amino acid sequences. These amendments are supported, for example, at page 39, line 23 to page 40, line 19; and figures 14-16. These amendments do not narrow the scope of these claims; thus, these claims are entitled to the same scope of equivalents as the original claims.

Claim 15 is objected to because of an inconsistency between the claim and the specification with respect to the name of a particular cell line. This claim has been amended to refer to particular deposits made with the European Collection of Cell Cultures. This amendment is supported, for instance, at page 15, lines 21-28 and page 25, lines 14-21.

Claim 24 is objected to as being a "use" claim. Cancellation of this claim because it is directed to non-elected subject matter renders this objection moot.

III. Response to Restriction Requirement

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In response to the restriction requirement mailed August 26, 2003, Applicants provisionally elect with traverse to prosecute the claims of Group II, which the Office Action lists as including claims 1-2, 4-16, 18-19 and 23. It would appear that claim 5 was inadvertently omitted from this group because it too is directed to antibody derivatives and is not listed in any of the other groups. The subject matter of new claims 25-27 also falls within the scope of Group I.

The restriction of the claims into Groups I and II is traversed because claims cannot be restricted without a showing by the Office that a search and examination of the claims on the merits would constitute an undue burden on the Office, *even when the claims are directed to independent and distinct inventions* (MPEP 803.01). In establishing that an "undue burden" exists, the Office must demonstrate that examination of the claims would involve substantially different prior art searches that renders co-examination unduly burdensome. To do this, the Office must demonstrate that the restricted groups have a separate classification, have acquired a separate status in the art, or that searching would require a search of different fields (MPEP 808.02).

The Office contends that the claims in these two groups are distinct. In response, it is noted that all the claims in Groups I and II are not only classified to the same class, *but also the same subclass*. The fact that all the claims in these groups have been *identically classified* demonstrates that a search of the claims in one of these five groups will be coextensive with the search of the claims in the other groups. As such, a search of the claims in one group would not unduly burden the Office. Moreover, a search of art regarding molecules capable of binding a particular antigen (in this instance, factor IX/factor IXa) would be expected to encompass both antibodies and antibody derivatives. For this reason also, it would not unduly burden the Office to search the claims in both Groups I and II.

It is thus requested that the claims in Groups I and II be examined together in this application.

IV. Species Elections

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Since it is Applicants' understanding that a species election is required only with respect to Groups V and VI, this requirement is deemed to be inapplicable to the current election since Applicants have provisionally elected the claims Group II.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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